

Application No. 10/810,554

Docket No. 86421-39

Remarks/Arguments

The patent application comprises twenty-five (25) claims. Claim 1 has been amended and claims 20 to 25 have been added. No new matter has been added to the claims by this response. Support for the amendments can be found throughout the present patent application, including the drawings and claims as originally filed.

A. Rejections Under Sections 102 and 103

In the Office Action, the Examiner rejected claims 1 to 3 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,381,877 (Filice).

The Examiner also rejected claims 4, 5 and 15 to 17 under 35 U.S.C. §103(a) as being unpatentable (obvious) over Filice in view of U.S. Patent 5,289,645 (Marcga *et al.*). Claims 6, 7, 18 and 19 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Filice and Marcga *et al.* in view of U.S. Patent 5,341,583 (Hallenbeck).

The Examiner further rejected claims 8, 9 and 14 under 35 U.S.C. §103(a) as being unpatentable over the aforesaid cited patents as applied to claim 4. Claims 10 to 13 were also rejected under 35 U.S.C. §103(a) as being unpatentable over the aforesaid cited patents as applied to claim 9 and in view of U.S. Patent 5,738,937 (Baychar).

The Applicant respectfully requests reconsideration of these rejections in view of the following remarks.

Application No. 10/810,554

Docket No. 86421-39

B. Patentability of Claims 1 to 19

According to MPEP § 706.02, in order to reject a claim under 35 U.S.C. § 102(b) as being anticipated by a patent, the Examiner must determine that such patent teaches every aspect of the claimed invention either explicitly or implicitly. Any feature not directly taught must be inherently present.

Claim 1 has been amended in order to specify features that are neither disclosed nor suggested by Filice. In this regard, the Applicant directs the Examiner's attention to the following highlighted features of amended claim 1

1. A skate boot for enclosing a foot of a player, the foot having a forefoot and a front ankle portion, said skate boot having a tongue comprising:
 - b) a first section covering the forefoot of the foot;
 - b) a second section connected to said first section via a flexing zone, said flexing zone enabling said second section to be movable between a first position, in which said second section covers a portion of the front ankle portion of the foot, and a second position, **in which said second section overlaps a portion of said first section, wherein, in use, the player can fold said second section over said first section for wearing said boot with said tongue in said second position.**

In the Office Action, the Examiner indicated that Filice discloses a skate boot having a tongue 20 comprising a first section 22 and a second section 24 connected to the first section 22 via a flexing zone 26, this flexing zone enabling the second section 24 to be movable between first and second position. The Examiner also indicated that "in said second position, said second section overlaps a portion of said first section (fold 24 over 22 to insert foot into boot)".

Application No. 10/810,554

Docket No. 86421-39

It appears that the Examiner considers that it is possible to fold the second section 24 over the first section 22 when the user inserts his/her foot into the boot. The Examiner will however agree that nowhere in Filice does the inventor teach or suggest that the second section of the tongue overlaps a portion of its first section, as recited in claim 1.

Moreover, the Examiner will appreciate that nowhere in Filice does the inventor teach or suggest that the player, in use, can wear the boot with the second section of the tongue overlapping its first section, as recited in claim 1. As indicated in the specification, the Applicant's tongue allows "a player who wears a leg pad that is long enough to cover the front ankle portion FAP, [...] to fold the second section 42 [of the tongue] over the first section 40 since his/her leg pad offers enough protection for his/her front ankle portion FAP. In that way, the second section 42 overlaps a portion of the first section 40 for providing further protection for a portion of the forefoot FF" [lines 20-24, page 6]. See also Figure 7 of the present patent application.

Filice does not therefore disclose nor suggest a skate boot having a tongue (i) with a flexing zone enabling the second section to overlap a portion of the first section; and (ii) that allows the player, in use, to fold the second section of the tongue over its first section for wearing the boot with the tongue in this position, as recited in claim 1.

Hence, the Applicant respectfully requests withdrawal of the Examiner's rejection pursuant to 35 U.S.C. § 102(b) and allowance of claim 1. Because claims 2 to 19 depend directly or indirectly from claim 1 and include by reference all of the features recited in claim 1, these claims are also patentable.

Application No. 10/810,554

Docket No. 86421-39

C. Patentability of New Claims 20 to 25

New claim 20 reads as follows:

20. A skate boot for enclosing a foot of a player, the foot having a forefoot and a front ankle portion, said skate boot having a tongue and an ankle portion with upper eyelets, said tongue comprising:

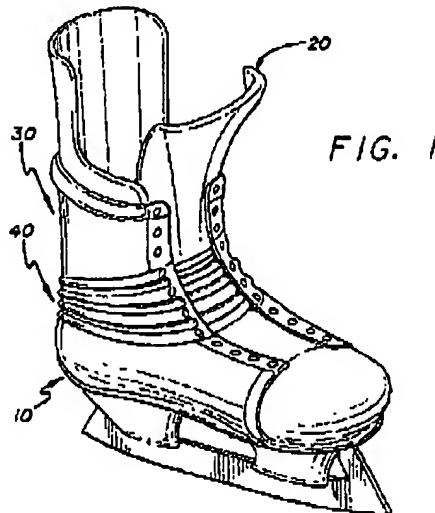
- a) a first section covering the forefoot of the foot;
- b) a second section connected to said first section via a flexing zone, said flexing zone being located slightly above said upper eyelets and enabling said second section to be movable between a first position, in which said second section covers a portion of the front ankle portion of the foot, and a second position, in which said second section overlaps a portion of said first section, wherein, in use, the player can fold said second section over said first section for wearing said boot with said tongue in said second position whereby further protection for a portion of the forefoot is provided.

Filice does not disclose nor suggest a skate boot having a tongue (i) with a flexing zone enabling the second section to overlap a portion of the first section; and (ii) that allows the player, in use, to fold the second section of the tongue over its first section for wearing the boot with the tongue in this position whereby further protection for a portion of the forefoot is provided, as recited in new claim 20.

Application No. 10/810,554

Docket No. 86421-39

The Examiner will also appreciate that nowhere in Filice does the inventor disclose or suggest a **flexing zone located slightly above the upper eyelets¹**, as recited in claim 20. Indeed, as shown in Figure 1 of Filice, the flexing zone 26 is located well below the upper eyelets:



Hence, the Applicant respectfully requests allowance of independent claim 20. Because claims 21 to 25 depend from claim 20 and includes by reference all of the features recited in claim 20, claims 21 to 25 are also patentable.

¹ Support for this feature can be found at lines 7-10, page 7: "In a non-limiting embodiment, the flexing zone 48 may be located high enough relative to the front ankle portion FAP, such that it is located slightly above the upper eyelets 36. In such a position, the second section 42 can be folded over the first section 40 when the wearer has laced the skate boot up to the upper eyelets."

Application No. 10/810,554

Docket No. 86421-39

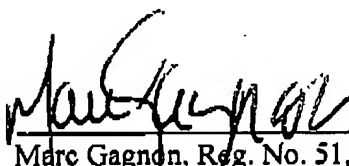
CONCLUSION

In view of the above amendments and remarks, it is submitted that each of pending claims 1 to 25 is in condition for allowance and the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) should be withdrawn.

The Examiner is invited to call the Applicant's undersigned patent agent if any further amendments will expedite the prosecution of the present patent application or if the Examiner has any suggestions or questions concerning this application or the present response. If the claims are not believed to be in full condition for allowance, the Applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP § 707.07(j) or in making constructive suggestions pursuant to MPEP § 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

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